

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated December 8, 2003, are respectfully requested. Claims 1-30 remain pending in this application.

Objection to the Drawings

Please substitute the enclosed new Fig. 3B. An annotated sheet showing changes is enclosed. Applicant respectfully requests the objection to the drawings be withdrawn.

The Rejections

Claims 21-22 and 27-28 were rejected under 35 U.S.C. 102(b) as being unpatentable over USPN 5,740,361 to Brown (hereafter "Brown"). Claims 1-9 and 12-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,493,722 to Daleen et al (hereafter "Daleen") further in view of USPN 6,023,684 to Pearson (hereafter "Pearson"). Claims 10-11 and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of USPN 5,857,191 of Blackwell, Jr. et al (hereafter "Blackwell"). Claims 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of USPN 5,758,324 to Hartman et al. (hereafter "Hartman"). Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman, further in view of Blackwell. Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of USPN 5,347,477 to Lee (hereafter "Lee"). Claims 23, 25 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of USPN 5,604,802 to Holloway (hereafter "Holloway"). Claims 24 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of USPN 6,122,622 of Wiitala et al. (hereafter "Wiitala"). Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of Hartman.

The Cited Art

Brown describes a system and method for authenticating users and services communicating over an insecure network. Each user and service has a pass-phrase used for

authentication. However, the pass-phrases are not revealed during the authentication process as challenge-response techniques are used to keep the pass-phrase secret. In addition, the users and services do not need to know nor do they learn each other's pass-phrases making the process useful in a distributed environment. Pass-phrases are known by an authentication entity with which the service communicates to authenticate both users and services. Users may have identities in and services may support a number of realms, each of which may be viewed as large collection of users (e.g., CompuServe.com). Users choose the realm in which they would like to be authenticated. The system and method may be adapted for use with the HyperText Transfer Protocol of the World Wide Web so that secure transactions may be accomplished between users and services communicating via the Internet.

Daleen describes a system, a method and a computer readable medium for distributing messages from a third-party to a group of subscribers by using subscriber information and subscriber preferences stored in a database so that the group of subscribers can form a community to negotiate a group purchase of a good and/or service from the third party. A subscriber selection system is used for querying the database using one or more subscriber criteria to form a group of one or more subscribers. The one or more subscriber criteria used to query the database is chosen by the third party, which allows the subscriber selection system to form a group of subscribers who satisfy the criteria for a type of subscriber that the third-party wants to send a message, such as an advertisement. A billing system, which is coupled to the database receives one or more messages from a third-party and then provides the one or more messages from the third party to the group of subscribers that was formed by the corresponding query of the database. The system allows the messages from the third-party to be distributed to the group of subscribers without revealing to the third party any of the potentially valuable or sensitive subscriber information stored in the database. In other words, all that a third-party knows is that its message is being sent to a group of subscriber who meet the criteria which the third-party selected. The message includes a contact address which is sent along to the subscribers in the group to form a community for purchasing of a good and/or service from a third party. The group of subscribers formed are sent the contact address with the messages received from the third party. The group purchase allows individuals and businesses to reduce costs by buying items in quantities.

Pearson describes a three tier financial transaction system having a local data memory. The three tier system includes a client interface, an application service, a host interface, and a

local data memory. The client interface communicates data messages between a client program and the financial transaction system. The client interface converts client requests to a format compatible with the application service so the application service may process client requests from client programs. At the initiation of a logical session with a client program, the application service refreshes data for the customer associated with the client program using data obtained from a back end processing system through the host interface. The data in the local data memory is then used by the application service for processing client requests during the logical session. Response data generated by the application service is provided to the client interface for presentation to the client program. Communication between the client program and the client interface is preferably performed over an open communication network. The local data memory permits the processing of the client service request to be decoupled from the updating of the back end processing system to improve response times for client request processing.

Blackwell describes a web browser that communicates through a secure local proxy to a web server that has an interface for secure communications. The application server has an application program conforming to the CGI programming model that can run continuously as a process and can maintain state information, such as pointers to next records, thus requiring less computational and memory overhead for a succession of requests.

Hartman describes a method of and apparatus for storage and retrieval of resume images in a manner which preserves the appearance, organization, and information content of the original document. In addition, summaries or "outlines" of resume images, broken down into multiple fields, are stored, and can be searched field by field. A user interface is provided which is based on a familiar paper-based method already in common use, thus reducing the training required to effectively use the system.

Lee describes a pen-based form computer using "Form" as the operation metaphor between users and the computer, which allows an user to directly operate the information stored in the computer or any remote systems without learning commands, file names, file types, and other details regarding computer internal structure. It is applicable for use in medical prescription control, order registration control, inventory inquiry control, data collection. It can also be used as a front-end system in a client and server structure. The pen-based form computer comprises a pen for data entry, and a complete Multi-tasking Preemptive Pen Based Form Operation software system for form operation metaphor, graphical form making

procedure, multiple form data association, multiple form operation language, remote form data accessing, automatic database association, and hand-writing recognition. External keyboard for data entry is acceptable. The preferred embodiment of the invention is within 2 lbs. and about the size of a B5 paper. It uses a pressure-sensitive touch panel overlaid LCD for data entry with the pen, and an infrared, RS-232, off-the-shelf modem, and radio transceiver as communication mediums.

Holloway describes a transaction processing system comprises at least one transaction terminal having means to receive characteristic data from a user, which characteristic data is required to generate a characteristic image associated with the user, such as an image of the user's signature, from data stored in a data processing system; and logic for generating a transaction message by combining transaction data with the characteristic data in such a way that the transaction data is required to recover the characteristic data from the message. The data processing system comprises means to store the user data, to receive and store the message, to recover the characteristic data from the message using the transaction data, and to reconstruct the characteristic image from the user data using the characteristic data to establish that the transaction was valid by associating the characteristic image with the transaction data.

Wiitala describes an automated system of integrated computer programs and files facilitates compliance with Chemical Control Laws of different jurisdictions. In one embodiment, the system uses a raw material database file, a formula database file, a manufacturing status database file, a sales status database file, a regulatory worksheet program, and an update program, all residing on a computer system. These files and programs are collectively used to: maintain Chemical Control Law inventories; maintain records of chemical and product Chemical Control Law registrations; provide a basis for automated control of chemical or product manufacturing, distribution, importing and exporting through the generation of country or regional manufacturing and sales status; generate certification letters; generate Chemical Control Law manufacturing and sales statuses for particular countries or regions of the world; and provide real-time updating of a chemical's or product's manufacturing and sales status.

Preliminary Comments Regarding Examiner's Rejections

To the extent that any of these cited references are considered to be prior art under 35 U.S.C. 102(a)/103(a) or 102(e)/103(a), for example, Applicant reserves the right to swear

behind these references at a later date. However, Applicant does not believe that it is necessary to do so for at least the reasons set forth below.

The Examiner rejected claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman. Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman, further in view of Blackwell. Applicant assumes that the Examiner therefore meant to reject claims 14-15 under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman, and only 16-17 under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman, further in view of Blackwell. Clarification is requested.

Applicant respectfully traverses the Examiner's rejections of the claims, and requests reconsideration based upon the following remarks.

Rejection of Claims 21-22 and 27-28

Claims 21-22 and 27-28 were rejected under 35 U.S.C. 102(b) as being unpatentable over Brown. However, it should be noted that Brown does not teach at least one limitation of independent claims 21 and 27 and, as such, cannot form the basis for a rejection under 35 U.S.C. 102(b).

With respect to claim 21, Brown does not teach, for example, at least partially automatically filling in an HTML based form based upon input from a client machine. Nor does Brown teach verifying information on the HTML form based upon stored heuristics. Still further, Brown does not teach submitting the HTML form, that has been at least partially automatically filled-in and then verified, to a receiving agency over a network.

The Examiner cites column 3, line 59-67 to support the position that the limitations of Brown are fully met by claim 21. Applicant respectfully points out that this disclosure by Brown actually teaches just the opposite position. The passage in question is set forth below:

One technique to address this problem is to have the service prompt the user for her pass-phase. For example, a WWW service may display a Hyper-Text Markup Language (HTML) form with two boxes--one that asks for the user for her user name and one that asks her for her pass-phrase. A protocol such as SSL or SHTTP may be used so an eavesdropper cannot see

it. When the service receives the user's reply, the service may use a challenge-response technique to verify the pass-phrase with a server that knows the pass-phrases. Brown, column 3, lines 59-67.

Brown therefore teaches that an HTML form is provided with two boxes: one for a user name and one for a pass-phrase. These are clearly manually entered by the user, since the automatic filling in of these boxes would defeat their purpose. Brown then uses a challenge-response technique to verify the pass-phrase. It should be noted that a challenge-response technique never transmits the data over a network where it could be compromised but, rather, sends information mathematically alluding to the pass-phrase for verification purposes. Form data would never be sent using a challenge-response technique. The use of a challenge-response technique clearly *teaches away* from verification using stored heuristics. The Examiner's assertion that a "receiving agency" is the server that verifies the pass-phrase is also incorrect, because a pass-phrase server is not provided with an HTML form when using a challenge-response technique.

The same arguments hold for independent claim 27, which recites computer readable media including code segments for performing the acts recited in claim 21. Brown clearly does not teach a code segments that can perform the act of, for example, at least partially automatically filling in an HTML based form based upon input from a client machine. Nor does Brown teach a code segment for verifying information on the HTML form based upon stored heuristics. Still further, Brown does not teach a code segment for submitting the HTML form, that has been at least partially automatically filled-in and then verified, to a receiving agency over a network.

Claims 21 and 27 are clearly patentable over Brown. Dependent claims 22 and 28 are clearly patentable over Brown for at least the same reasons. Applicant respectfully requests that the rejections be withdrawn.

Rejection of Claims 1-9 and 12-13

Claims 1-9 and 12-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson. Applicant respectfully traverses as set forth below.

Applicant teaches the combination of a web server, a receiving agency server, and client machine all coupled together by a wide area network. The client machine is in communication

with the web server, which serves as an interface to the receiving agency server for the filing of electronic documents with the receiving agency server. Daleen and Pearson, in combination, do not show this combination of elements.

The Examiner makes a fundamental error in his analysis of Daleen. That is, the Examiner paraphrased Daleen as saying "people identify databases as electronic filing systems, and Daleen's invention encompasses a database (item 104 in Fig. 1)." However, Daleen is clearly stating that his database is an electronic filing cabinet. Daleen does not mean (contrary to the assertion of the Examiner) that his (or any) database is capable of filing electronic forms over a wide area network with receiving agency servers. It is clear that the Examiner has completely misinterpreted the meaning of the phrase "electronic filing systems." That is, Daleen uses the phrase "electronic filing system" to mean a database on a computer system, not as *the action of filing an electronic form over a wide area network*. This distinction is clearly taught by Daleen as follows:

Database--A collection of information organized in such a way that a computer program can quickly select desired pieces of data. People often think of a database as an electronic filing system. Traditional databases are organized by fields, records, and files. A field is a single piece of information; a record is one complete set of fields; and a file is a collection of records. For example, a telephone book is analogous to a file. It contains a list of records, each of which consists of three fields: name, address, and telephone number. An alternative concept in database design is known as hypertext. In a hypertext database, any object, whether it be a piece of text, a picture, or a film, can be linked to any other object. Hypertext databases are particularly useful for organizing large amounts of disparate information, but they are not designed for numerical analysis. A specific implementation of a database may be referred to as a Relational Database. Daleen, column 4, lines 5-21.

The Examiner admits that Daleen does not use an intermediate web server between the client machine and the receiving agency. However, Pearson does not cure this deficiency. Pearson, in his Fig. 2, shows a functional depiction of an information system. There is no disclosure or hint of the claimed combination of a web server, receiving agency server, and client machine coupled together by a wide area network, where the web server serves as an intermediary between the client machine and the receiving agency computer.

Even if we accept, *arguendo*, that the analogies made the examiner are valid, they still do not show the claimed combination. That is, the Examiner indicates that "as implied by

Pearson's discussion of the setup of servers in col. 1-21 ... Pearson's discussion and the Figure indicates that one may employ a path such as a path from the client (26 or 28) to the web server (50) to the application server (56)." This is clearly unsupportable, as set forth below.

First, it should be noted that there are only 18 columns in this patent, so the reference to columns 1-21 is not understood, and would encompass the entire patent application, including the claims. Furthermore, it should be noted that Fig. 2 shows functional interrelationships, not physical connections. See, for example:

Although the servers 56, 58, and 60 are shown coupled in point-to-point links, FIG. 2 illustrates data flow and not physical connections. Thus, the reader should appreciate that servers 56, 58, and 60 may be coupled in a ring network or other physical connecting configuration. Pearson, column 8, lines 20-23.

It is clear that there is no contemplation that the application server 56 is either a receiving agency server or connected to the Internet. That is, the web server 50 and clients 26, 28 are clearly connected to the Internet 34, and the application server 56 is not. What Pearson is disclosing is a traditional support server for back-end processing.

Since independent claim 1 is clearly patentable over Daleen and Pearson, Applicant respectfully requests that the rejection be withdrawn. Furthermore, and since claims 2-9 and 12-13 are either directly or indirectly dependent on claim 1, they are patentable for at least the same reasons. Applicant respectfully requests the withdrawal of the rejection of claims 1-9 and 12-13.

Rejection of Claims 10-11 and 18-19

Claims 10-11 and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Blackwell. Claims 10-11 and 18-19 are dependent, either directly or indirectly from claim 1, and are therefore allowable for at least the same reasons as set forth with respect to Daleen and Pearson. Blackwell is, apparently, presented to show that encryption can be added to HTTP. Blackwell adds nothing to Daleen or Pearson with respect to the allowability of claim 10-11 and 18-19 in that these claims incorporate limitations of claim 1 that are not found in Daleen, Pearson or Blackwell. Applicant respectfully requests the withdrawal of the rejection of claims 10-11 and 18-19.

Rejection of Claims 14-15

Claims 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman. Claims 14 and 15 are dependent, either directly or indirectly from claim 1, and are therefore allowable for at least the same reasons as set forth above with respect to Daleen and Pearson. Hartman, apparently, is presented to show an "applicant machine" which, by the admission of the Examiner, is not connected to a wide area network. He also admits that Daleen and Pearson also do not disclose an applicant machine coupled to a wide area network. As such, the Examiner admits that claimed element of "an applicant machine coupled to said wide area network" is missing from the combined disclosures of Daleen, Pearson, and Hartman. Applicant respectfully requests that the rejection of claims 14-15 be withdrawn as well.

Rejection of Claims 16-17

Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Hartman, further in view of Blackwell. Claims 16 and 17 are indirectly dependent from claim 1, and are therefore allowable for at least the same reasons as set forth with respect above with respect to Daleen and Pearson. As also set forth above, Hartman and Blackwell add nothing to this rejection, since they do not cure the deficiencies in Daleen and Pearson. Applicant respectfully requests that the rejection of claims 16-17 to be withdrawn as well.

Rejection of Claim 20

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen, further in view of Pearson, further in view of Lee. Claim 20 is indirectly dependent upon claim 1 and, therefore, is patentable for at least the same reasons as claim 1 with respect to Daleen and Pearson. Lee is presented to show the automatic filling of forms. Applicant respectfully traverses. Lee teaches handwriting recognition for filling in forms. Lee does not teach the automatic filling of forms and, in fact, teaches away from the automatic filling of forms. That is, with Lee a user fills in, by hand, everything that needs to be entered into the form. Lee then recognized the handwriting and replaces the handwriting with recognized text. There is no automatic filling of forms described or suggested by Lee. Applicant respectfully requests that the rejection of claim 20 be withdrawn.

Rejection of Claims 23, 25 and 29

Claims 23, 25 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway. Claims 23, 25, and 29 are indirectly dependent upon claim 21, and are therefore patentable over Brown for at least the reasons as set forth above. Holloway teaches electronic signatures, but not electronic signatures within the context of the limitations of the method claims. Furthermore, Holloway does not cure the deficiencies of Brown with respect to the independent claim 21. Applicant respectfully requests that the rejections of claims 23, 25, and 29 be withdrawn.

Rejection of Claims 24 and 30

Claims 24 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of Wiitala. Claims 24 and 30 are also indirectly dependent upon claim 21, and are therefore patentable over Brown for the reasons set forth above. Wiitala is submitted to indicate that a filing fee should be presented with a form to facilitate registration. However, the Examiner misstates the disclosure of Wiitala. Wiitala is directed to compliance with Chemical Control Laws. The only disclosure of a filing fee in the application is in the "Description of Related Art" area with reference to the un-automated manner of complying with such laws in the prior art. For example, Wiitala discloses:

Product-based laws require registration of the exact chemical composition of each product (i.e., finished good) with the proper government authorities of the end-use country or region. Registration typically involves submission of a completed form and a filing fee. Wiitala Description of Related Art, column 1, lines 47-48

It is clear that there is no hint or suggestion in Wiitala of an electronically submitted form provided with a filing fee. Furthermore, neither Holloway nor Wiitala cure the deficiencies of Brown with respect to independent claim 21, let alone dependent claims 24 or 30. Applicant respectfully requests that the rejections of claims 24 and 30 be withdrawn.

Rejection of Claim 26

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of Hartman. Claim 26 is also indirectly dependent upon claim 21, and are therefore patentable over Brown for the reasons set forth above. As explained above, neither Holloway nor Hartman cure the deficiencies of Brown with respect to

independent claim 21, and they certainly don't cure the deficiencies with respect to claim 26 which is indirectly dependent thereupon. The rejection of claim 26 should also be withdrawn.

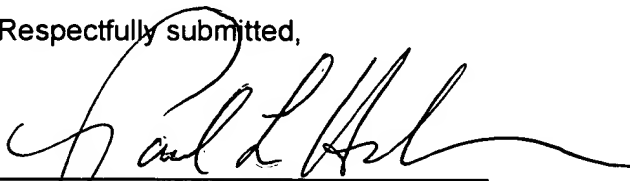
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Conclusion

For at least the forgoing reasons, Applicant believes that all pending claims are patentable over the art of record. A Notice of Allowance is respectfully requested. Should the Examiner believe that a telephone conference would expedite the prosecution of the present application, the undersigned can be reached at (650) 838-4443.

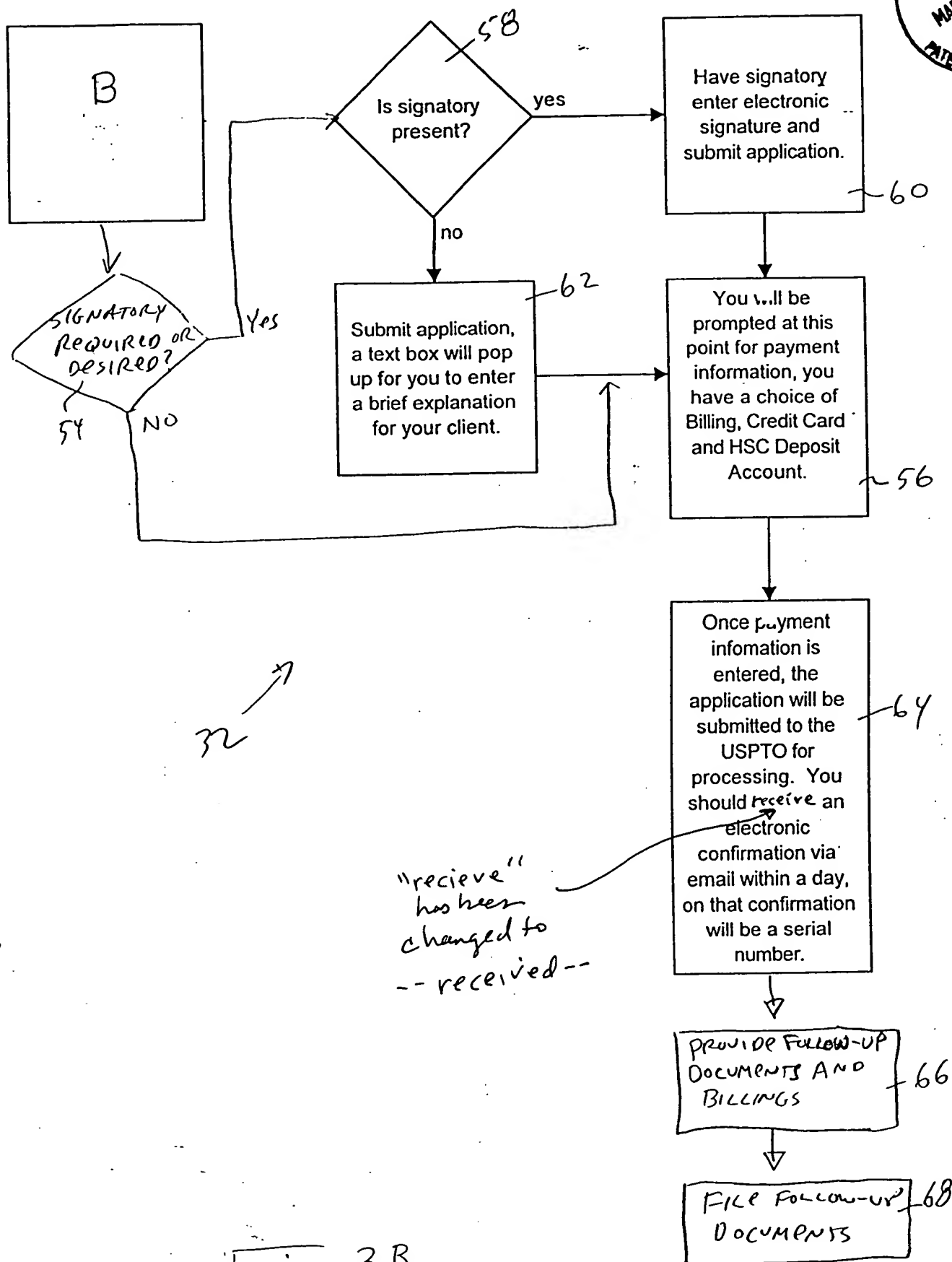
Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul L. Hickman", written over a horizontal line.

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32

"recieve" has been changed to -- received --

Fig. 3B